PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): **Art H. Burget et al.**

Confirmation No.: **9679**

Application No.: **10/652,010**

Examiner: **Aravind K. Moorthy**

Filing Date: **August 29, 2003**

Group Art Unit: **2431**

Title: **Method and System for Controlling Access of Clients and Users to a Print Server**

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on ____August 6, 2009____ .

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

Respectfully submitted,

Art H. Burget et al.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Patent Application of

Art H. Burget et al.

Application No. 10/652,010

Filed: August 29, 2003

For: Method and System for Controlling
      Access of Clients and Users to a
      Print Server

Group Art Unit: 2131

Examiner: MOORTHY, Aravind K.

Confirmation No.: 9679

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

  This is a Reply Brief under Rule 41.41 (37 C.F.R) in response to the Examiner's

Answer of August 6, 2009 (the "Examiner's Answer" or the "Answer"). In Section 10, the

Answer contains a response to some of the arguments made in Appellant's brief. Appellant

now responds to the Examiner's Answer as follows.

Status of Claims

Claims 5 and 39 have been cancelled previously without prejudice or disclaimer.

Thus, claims 1-4, 6-38 and 40-46 are pending in the application and stand finally rejected.

Accordingly, Appellant appeals from the final rejection of claims 1-4, 6-38 and 40-46, which

claims are presented in the Appendix.

Grounds of Rejection to be Reviewed on Appeal

The final Office Action raised the following grounds of rejection.

(1)   Claims 13-18, 30-38 and 40-46 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 7,305,556 to Slick ("Slick").

(2)   Claims 1-4, 6-10 and 19-29 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Slick and U.S. Patent App. Pub. No. 2002/0169002 to Imbrie et al. ("Imbrie").

According, Appellant hereby requests review of each of these grounds of rejection in the present appeal.

Argument

<u>(1)   Claims 13-18, 30-38 and 40-46 are patentable over Slick:</u>

<u>Claim 13:</u>

Independent claim 13 recites:

> A method of controlling a user's ability to cause a client to send a print job to a printer, said method comprising providing said client with a key specifically configured for said user, wherein said client will refuse to submit a print job to said printer for a particular user unless said key associated with that user has been provided to said client.

Appellant again wishes to point out that claim 13 recites that the "client will refuse to submit a print job … for a particular user unless [a] key associated with that user has been provided to said client." Despite a lengthy discussion in the Answer regarding this issue, the Answer still fails to indicate how or where Slick teaches or suggests a printer client refusing to submit a print job for a particular user unless a key associated with that user has been provided to the client.

As noted previously, Slick describes a method of securing a printer public key by encryption. The printer public key is encrypted with a user-specific private key. (Slick, Fig. 8A, S805). Slick then teaches that the printer public key is decrypted with the user-specific private key and used to encrypt a print job being sent to a printer which holds the matching printer private key. (Slick, Fig. 8A and corresponding text). Consequently, according to the Answer, "a user will not be able to submit print data (i.e. encrypted print data) to the printer without possession of the user-specific keys. Without the user specific keys, a user will not be able to decrypt the printer public key and submit print jobs." (Answer, p. 14).

Respectfully, the Answer is confusing *successfully* submitting a print job with the claimed refusal of a client to submit a print job at all. Under the teachings of Slick, if a user cannot access the printer's public key, the user cannot then use that key to encrypt a print job

being sent to the printer. However, the user may still send an unencrypted or incorrectly encrypted print job to the printer.

The printer may refuse this print job. Yet, there is nothing in the teachings of Slick that indicates that the user cannot, from the printer client, send an unencrypted or incorrectly encrypted print job to the printer. Slick never teaches or suggests that the printer client will, under any circumstances, "*refuse*" to attempt submission of a print job.

In contrast, claim 13 expressly recites "said client will refuse to submit a print job to said printer for a particular user unless said key associated with that user has been provided to said client." (Claim 1). Clearly, the Answer and previous prosecution have failed to identify this subject matter in the prior art.

Respectfully, to anticipate a claim, a reference must teach each and every element of the claim, and "the identical invention must be shown *in as complete detail as contained in the ... claim*." MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, "[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)).

In the present case, Slick clearly does not disclose the claimed invention with each and every claimed element in the same amount of detail or as arranged in the claim. . Slick never teaches or suggests that the printer client will, under any circumstances, refuse to attempt submission of a print job. Consequently, because Slick clearly fails to satisfy the

requirements for anticipating claim 13, the rejection of claim 13 and its dependent claims should not be sustained.

Claim 30:

Independent claim 30 recites:

> A system for controlling a user's ability to cause a client to print a print job to a printer on a network, said system comprising:
> a client; and
> a print server for managing at least one network printer, wherein said print server provides a key to said client for use in submitting a print job, said key being specific to a particular user of said client;
> *wherein said client will refuse to submit a print job for a user unless said client has been previously provided with a key specific to that user.*

(Emphasis added).

However, as demonstrated above with respect to claim 13, Slick never teaches or suggests that the printer client will, under any circumstances, refuse to attempt submission of a print job. Consequently, Slick clearly does not teach or suggest the claimed system in which "said client will refuse to submit a print job for a user unless said client has been previously provided with a key specific to that user.

Again, to anticipate a claim, a reference must teach each and every element of the claim, and "the identical invention must be shown *in as complete detail as contained in the ... claim.*" MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, "[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)).

In the present case, Slick clearly does not disclose the claimed invention with each

and every claimed element in the same amount of detail or as arranged in the claim.   . Slick

never teaches or suggests that the printer client will, under any circumstances, refuse to

attempt submission of a print job. Consequently, because Slick clearly fails to satisfy the

requirements for anticipating claim 30, the rejection of claim 30 and its dependent claims

should not be sustained.

Claim 38:

Independent claim 38 recites:

> A system controlling use of a printer on a network, said system comprising:
> a client connected to said network for generating a print job for said printer;
> means for providing a key to said client, wherein said key is specific to a user
> of said client and is *used to encrypt a print job* from said client to said printer.
> *means on said client for encrypting said print job using said key to produce an*
> *encrypted print job for transmission to said printer.*

(Emphasis added).

In contrast, as demonstrated above, Slick only teaches the use of user-specific keys for

encrypting and securing the printer public key. When a print job is to be encrypted, the

printer public key is accessed and is then used to encrypt the print job. This is not what claim

38 recites.

Claim 38 recites a key that "is specific to a user of said client" and that such a user-

specific key is "*used to encrypt a print job*." (Claim 38). Thus, the claim clearly states that

the key specific to the user is used to encrypt a print job.

In contrast, Slick teaches that the user-specific key is merely used to access the printer

public key. It is then the printer public key, not the user-specific key, that is used to encrypt a

print job. (Slick, col. 3, lines 32-58).

Again, the standard to anticipate a claim is high. To anticipate a claim, a reference must teach each and every element of the claim, and "the identical invention must be shown *in as complete detail as contained in the ... claim.*" MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, "[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)).

In the present case, Slick clearly does not disclose the claimed invention with each and every claimed element in the same amount of detail or as arranged in the claim.   . Slick never teaches or suggests the claimed key that "is specific to a user of said client" and that such a user-specific key is "*used to encrypt a print job.*" (Claim 38). Consequently, because Slick clearly fails to satisfy the requirements for anticipating claim 38, the rejection of claim 38 and its dependent claims should not be sustained.

Claims 6 and 15:

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art.   Specific, non-exclusive examples follow.

Dependent claims 6 and 15 disclose "storing a related key on a storage device of said print server." In response, the Action cites to Slick, column 8 lines 9-17, which teach that a "storage area 62 includes printer public key." When examined in context, it becomes readily apparent that "storage area 62" is "a general storage area of fixed disk 13," (column 8, lines 9-17) which is described as one of the internal contents of "computer 10" (Slick, column 6,

lines 22-24). Computer 10 is analogous to the client disclosed in claim 14, and not the print

server. Thus, nowhere does Slick teach or suggest that the related key is stored "on a storage

device of said print server" (claims 6, 15).

The Answer contains no substantive response to the preceding argument.

Accordingly, it remains clear that Slick does not teach or suggest the print server and related

subject matter of claims 6 and 15.

(2)   Claims 1-4, 6-10 and 19-29 are patentable over Slick and Imbrie:

Claim 1:

Independent claim 1 now recites

> A method of controlling use of a printer on a network, said method
> comprising:
>   with a print server, generating a key for a specific client of said print server;
>   embedding said key in a printer driver;
>   providing said key to said specific client on said network by installing said
> printer driver on said specific client, wherein said key is used to submit a print job
> from said client to a printer on said network.

(Emphasis added.)

The cited prior art clearly fails to teach or suggest any of the features of claim 1.

The cited prior art has not been shown to teach or suggest a method that includes,

"with a print server, generating a key for a specific client of said print server." (Claim 1). In

this regard, the Answer argues as follows.

> Appellant argues that Imbrie fails to teach or suggest "with a print server, generating a
> key for a specific client of said print server". The examiner respectfully disagrees.
> Imbrie was not used to teach this feature. A discussed above, Slick discloses that the
> Microsoft CAPI generates a user-specific key pair for each user of computer 10 and
> stores each user-specific key pair in a registry entry for the particular corresponding
> user [column 6, lines 59-62].

(Answer, p. 17).

Appellant would like to point out that the Microsoft CAPI referred to is part of the "Microsoft Windows operating system which includes a cryptographic application programming interface (CAPI)." (Slick, col. 6, lines 50-56). It is the "fixed disk 13 of computer 10 [the printer client, that] includes operating system 40 … preferably a Microsoft Windows operating system which includes a cryptographic application programming interface (CAPI). (*Id.*).

Consequently, the Answer appears to be mistaking an interface (CAPI) of the local Windows operating system as being the claimed "printer server." Obviously, one of skill in the art would appreciate that the CAPI of the local operating system is not a printer server within the meaning of Appellant's claims and specification.

Thus, the cited prior art has *not* been shown to teach or suggest the claimed method that includes, "with a print server, generating a key for a specific client of said print server." (Claim 1).

Claim 1 next recites "embedding said key in a printer driver." It must be appreciated that the "said key" recited is one that was generated by a print server and is "for a specific client of said print server." This client-server relationship further makes clear that the claimed client and server are separate components. As there is no teaching in the cited prior art of any method involving such a print server, the claimed relationship between the key and a specific client of such a print server is clearly not in the cited prior art either.

In this regard, the Answer cites to Imbrie at paragraph 0037. (Answer, p. 18). According to this paragraph of Imbrie "a ***public*** key can be provided and embedded within the print driver for use with a later generated private key to encrypt or decrypt data packets transmitted from the printing assembly." (Imbrie, paragraph 0037) (emphasis added). This

clearly has nothing whatsoever to do with the claimed key that is generated for a specific

client of a printer server and then embedded in a printer driver.

Thus, the cited prior art has *not* been shown to teach or suggest the claimed method

that includes, "embedding said key in a printer driver," where the key is specific to a

particular client of a print server. (Claim 1).

Lastly, claim 1 recites "providing said key to said specific client on said network by

installing said printer driver on said specific client, wherein said key is used to submit a print

job from said client to a printer on said network." As demonstrated above, the cited prior art

does not teach or suggest the server-generated key or the printer driver in which such key is

embedded. Consequently, the cited prior art must also fail to teach or suggest this specific

method of providing the key to the corresponding specific client by installing the printer

driver.

As demonstrated above, the user-specific key taught by Slick is generated on that

user's own machine by the Windows operating system. (Slick, col. 6, lines 50 *et seq*).

Consequently, the key is not provided to that computer through the installation of a printer

driver, as recited in claim 1. The Answer utterly fails to appreciate or address this failing of

the cited prior art.

Consequently, as demonstrated here, the cited prior art fails to teach or suggest any of

the elements of claim 1.

The Supreme Court recently addressed the issue of obviousness in *KSR Int'l Co. v.*

Teleflex Inc., 127 S.Ct. 1727 (2007). The Court stated that the *Graham v. John Deere Co. of*

Kansas City, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the

analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under §

103, the scope and content of the prior art must first be determined, followed by an

assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Slick and Imbrie, did not include the claimed subject matter, particularly a method that includes, "with a print server, generating a key for a specific client of said print server; embedding said key in a printer driver; providing said key to said specific client on said network by installing said printer driver on said specific client, wherein said key is used to submit a print job from said client to a printer on said network." As demonstrated above, the final Office Action has failed to correctly assesses the differences between the cited prior art and claimed subject matter.

The differences between the cited prior art and the claimed subject matter are significant because, as demonstrated above, the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 1 and its dependent claims under 35 U.S.C. § 103 and *Graham*.

Claim 19:

Claim 19 recites:

A system for controlling a client's ability to send a print job to a printer on a network, said system comprising:
at least one client;
a print server for managing distribution of print jobs to one or more printers; and
a network connecting said at least one client device, said print server and said one or more printers;
wherein said print server generates a key for a specific client of said print server, embeds said key in a printer driver; and installs said printer driver on said specific client, said printer server than requires said specific client to use said key provided to said client when said client is submitting a print job to said print server.

Like claim 1 above, claim 19 recites a system that comprises at least one client and a print server managing distribution of print jobs to one or more printers "wherein said print server generates a key for a specific client of said print server, embeds said key in a printer driver; and installs said printer driver on said specific client, said printer server then requires said specific client to use said key provided to said client when said client is submitting a print job to said print server." As demonstrated above, the combination of Slick and Imbrie does not teach or suggest the claimed print server that "generates a key for a specific client of said print server, embeds said key in a printer driver; and installs said printer driver on said specific client."

Claim 19 further recites that the "print server," as opposed to some other constituent of the system, "requires said specific client to use said key provided to said client when said client is submitting a print job to said print server." All this subject matter is clearly outside the scope and content of the cited prior art.

As noted above, the Supreme Court recently addressed the issue of obviousness in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). The Court stated that the *Graham v. John Deere Co. of Kansas City*, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Slick and Imbrie, did not include the claimed subject matter, particularly a system in which a "print server generates a key for a specific client of said print server, embeds said key in a printer driver; and installs said printer driver on said specific client, said printer server then requires said specific client to use said key provided to said client when

said client is submitting a print job to said print server." As demonstrated above, the final

Office Action has failed to correctly assesses the differences between the cited prior art and

claimed subject matter.

The differences between the cited prior art and the claimed subject matter are

significant because, as demonstrated above, the claimed subject matter provides features and

advantages not known or available in the cited prior art. Consequently, the cited prior art will

not support a rejection of claim 19 and its dependent claims under 35 U.S.C. § 103 and

Graham.

In view of the foregoing, it is submitted that the final rejection of the pending claims

is improper and should not be sustained. Therefore, a reversal of the Rejection of September

18, 2008 is respectfully requested.

Respectfully submitted,

DATE: October 6, 2009   /Steven L. Nichols/
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